

REMARKS**Summary of the Office Action**

Claims 1-3 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,362,928 to Hamai et al. (hereinafter "Hamai").

Claims 1-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hamai further considered with either U.S. Patent No. 6,721,489 to Benyamin et al. (hereinafter "Benyamin") or U.S. Patent No. 6,542,445 to Ijichi et al. (hereinafter "Ijichi").

Claims 4-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1-3 as stated in either paragraphs 1 or 2 above, and further in view of U.S. Patent No. 5,619,483 to Yokota et al. (hereinafter "Yokota").

Claims 8-16, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 as stated in either paragraphs 1 or 2 above, and further in view of U.S. Patent No. 5,987,417 to Heo et al. (hereinafter "Heo").

Claims 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 as stated in paragraphs 1 or 2 above, and further in view of U.S. Patent No. 6,226,441 to Hartung et al. (hereinafter "Hartung").

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claims 1-3 as stated in paragraphs 1 or 2 above, and further in view of the allegedly "well known word processing nomenclature and the Dewey-Decimal system."

Summary of the Response to the Office Action

Applicants have canceled claims 12 and 13 without prejudice or disclaimer. Applicants have also amended claims 1, 2, 4, 6-9, 14-15 and 17-18 to differently describe embodiments of

the disclosure of the instant application's specification. Accordingly, claims 1-11 and 14-24 are currently pending for consideration.

Rejections under 35 U.S.C. § 102(e) and 103(a)

Claims 1-3 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hamai. Claims 1-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hamai further considered with either Benyamin or Ijichi. Claims 4-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1-3 as stated in either paragraphs 1 or 2 above, and further in view of Yokota. Claims 8-16, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 as stated in either paragraphs 1 or 2 above, and further in view of Heo. Claims 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 as stated in paragraphs 1 or 2 above, and further in view of Hartung. Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claims 1-3 as stated in paragraphs 1 or 2 above, and further in view of the allegedly "well known word processing nomenclature and the Dewey-Decimal system."

Applicants have canceled claims 12 and 13 without prejudice or disclaimer, rendering the rejections of these claims moot. Accordingly, withdrawal of the rejections of claims 12 and 13 is respectfully requested. Applicants have also amended claims 1, 2, 4, 6-9, 14-15 and 17-18 to differently describe embodiments of the disclosure of the instant application's specification. To the extent that these rejections might be deemed to apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

The Examiner asserts that Hamai discloses data tracks formed with respect to each data track group. However, Applicants respectfully traverse such an assertion because in Hamai, the number of the tracks included in data track group is controlled by the controller 2 via the switch 78. See col. 36, lines 53-54 of Hamai. In other words, the number of the tracks is not controlled in accordance with a user's instruction in Hamai. This is because grouped data is fixed-length data in Hamai. See col. 22, lines 51-53 of Hamai. One grouped data is assigned to m tracks (m is a positive integer) in Hamai. See col. 22, lines 46-47 of Hamai. Therefore, Applicants respectfully submit that one track data is fixed-length data. In other words, the number of grouped data depends on the size of inputted data in Hamai. If the size of inputted data exceeds the fixed-length of one grouped data, then a plurality of grouped data are generated. Accordingly, Applicants respectfully submit that a track in Hamai is not a unit which a user can access, and a grouped data in Hamai is not information which a user can control.

On the other hand, in embodiments of the disclosure of the instant application, as described in newly-amended independent claim 1 of the instant application, a track is a minimum unit which is designated at the time of reproducing the information. In other words, a user can choose at least one track, such as a tune, when he reproduces information recorded as a track. In newly-amended independent claim 1, this feature is described, for example, as "said each track being a minimum unit which is designated at the time of reproducing the information."

Further, in the present invention, as described by the combination of features of independent claim 1, for example, the user can determine a range of tracks to be included in one group. For example, if a recording of tracks is being performed and the user desires to assign three tracks from a first track to a third track as one group, he provides an interruption instruction to an apparatus when the recording of the third track is in progress or after the recording of the

third track is finished. Then, the inputting operation device performs an inputting operation relating to the interruption in accordance with the user's instruction. The detection device gives a grouping instruction to the information attaching and generating device at the time when the inputting operation relating to the interruption is detected while the recording is being performed. The recording device interrupts a recording after finishing the recording of the third track. Further, the information attaching and generating device generates the group control information to control the three tracks as one group when the grouping instruction is received.

This group is made up of one or a plurality of tracks recorded during a period from a start of the recording to an interruption of the recording. That is, the first, second and third tracks are included in the group. If the recording is resumed and the next interruption instruction is provided, the next grouping instruction is given. Then, the information attaching and generating device updates the group control information so as to control one or a plurality of tracks recorded so far. That is, the information attaching and generating device, as described in the combination of features of newly-amended independent claim 1 of the instant application, updates the group control information so as to control one or a plurality of tracks as a new group every time the grouping instruction is received.

Applicants respectfully submit that these advantageous and novel features of embodiments of the disclosure of the instant application are described in the combination of features of newly-amended independent claim 1, but not disclosed, nor even suggested, in the applied Hamai reference to any extent. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 102(e) be withdrawn.

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Examiner asserts that a process of making play lists is described in Benyamin and Ijichi.

However, Applicants respectfully submit that such an interpretation is not technically accurate for at least the following reasons.

In Ijichi, a playlist creation process is described in col. 10, line 41 - col. 12, line 12 and FIG. 8. In such an arrangement, first, the track number and song titles recorded on the track is displayed on a list in the display section. See col. 10, lines 63-65 of Ijichi. Then, a user selects the desired track number by operating keys. See col. 11, lines 3-9 of Ijichi. Therefore, the disclosure of Ijichi is based on the premise that all the tracks have been already recorded. As a result, it is clear that the playlist creation process in Ijichi is not performed while a recording of tracks is being performed.

On the other hand, in the present invention, as described in newly-amended independent claim 1 of the instant application, the detection device gives a grouping instruction to the information attaching and generating device at the time when the inputting operation relating to an interruption of a recording is detected while the recording is being performed. The information attaching and generating device generates the group control information to control one or a plurality of tracks as one group when the grouping instruction is received. This group is constituted of one or a plurality of tracks recorded during a period from a start of the recording to an interruption of the recording.

In addition, the information attaching and generating device updates the group control information so as to control one or a plurality of tracks as a new group every time the grouping instruction is received.

Applicants respectfully submit that at least these advantageous and novel features of the combination described in newly-amended independent claim 1 of the instant application are not disclosed, nor even suggested in Ijichi to any extent.

Applicants respectfully submit that Benyamin discloses that the track is automatically added to the particular play list. See col. 15, lines 44-45 of Benyamin. However, this process is not performed in accordance with a user's instruction. Actually, col. 13, line 47 of Benyamin explains that the user adds criteria to the play list. However, this operation is not a trigger of the play list creation process. In Benyamin, an apparatus is monitoring the hard disk, floppy disk, network, Internet, and the like. Then, after a new track is detected, and the criteria is satisfied, a track is automatically added to the particular play list. See col. 15, lines 15-45 of Benyamin. That is, the play list creation process in Benyamin is not performed in accordance with the user's instruction while a recording of track is being performed in the manner described in newly-amended independent claim 1 of the instant application.

On the other hand, the present invention, as described in newly-amended independent claim 1, includes specific recitations of the above-described features in combination with each other. For example, independent claim 1 of the instant application explains that the grouping operation is performed in accordance with a user's specific instruction while track recording is in the process of being performed.

Applicants respectfully submit that these advantageous and novel features of the combination of independent claim 1 of the instant application are not disclosed nor suggested in Benyamin to any extent.

Therefore, Applicants respectfully submit that even assuming, strictly arguendo, that a skilled person might combine Hamai, Ijichi and Benyamin in the manner asserted by the Office Action, this skilled person still could not obtain the particular combination of features recited in newly-amended independent claim 1 of the instant application for at least the foregoing reasons.

Accordingly, Applicants respectfully submit that the rejections under 35 U.S.C. § 103(a) should be withdrawn.

In summary, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(e) and 103(a) should be withdrawn because none of Hamai, Benyamin, or Ijichi, whether taken singly or combined, teach or suggest each feature of independent claim 1, as amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicant respectfully asserts that the dependent claims are allowable at least because of their dependence from claim 1 and the reasons set forth above.

Moreover, Applicant respectfully submits that the additionally applied reference to Yokota, with respect to claims 4-7, does not cure the deficiencies discussed above with regard to Hamai, Benyamin, or Ijichi. Moreover, Applicant respectfully submits that the additionally applied reference to Heo, with respect to claims 8-16, 21 and 22, does not cure the deficiencies discussed above with regard to Hamai, Benyamin, or Ijichi. Moreover, Applicant respectfully submits that the additionally applied reference to Hartung, with respect to claims 17-20, does not cure the deficiencies discussed above with regard to Hamai, Benyamin, or Ijichi. Moreover, Applicant respectfully submits that the additionally applied "word processing nomenclature and

the Dewey-Decimal system,” with respect to claims 23 and 24, does not cure the deficiencies discussed above with regard to Hamai, Benyamin, or Ijichi.

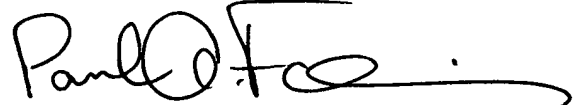
CONCLUSION

In view of the foregoing, Applicants submit that the pending claims currently under consideration are in condition for allowance, and respectfully request reconsideration and timely allowance of these claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP



By:

Paul A. Fournier
Reg. No. 41,023

Dated: September 13, 2006

Customer No. 055694
DRINKER BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, DC 20005-1209
Tel.: (202) 842-8800
Fax: (202) 842-8465